

REMARKS

The 2nd Supplemental Office action mailed on 14 November 2006 (Paper No. 20061003) has been carefully considered.

Claims 1 and 11 are being amended, and claim 37 is being added. Thus, claims 1, 4 thru 12, 15 thru 24 and 26 thru 37 are pending in the application.

In paragraph 3 of the Office action, the Examiner rejected claims 1, 4 thru 12, 15 thru 22, 27 thru 29 and 31 thru 34 under 35 U.S.C. §102 for alleged anticipation by Kuo *et al.*, U.S. Patent No. 6,226,040. In paragraph 5 of the Office action, the Examiner rejected claims 30 and 36 under 35 U.S.C. §103 for alleged unpatentability over Kuo *et al.* '040. In paragraph 6 of the Office action, the Examiner rejected claims 23, 24 and 35 under 35 U.S.C. §103 for alleged unpatentability over Kuo *et al.* '040 in view of Suen *et al.*, U.S. Patent No. 6,552,750. In paragraph 7 of the Office action, the Examiner rejected claim 26 under 35 U.S.C. §103 for alleged unpatentability over Kuo *et al.* '040 in view of Kim, U.S. Patent No. 6,473,130. For the reasons stated below, it is submitted that the invention recited in the claims, as now amended, is distinguishable from the prior art cited by the Examiner so as to preclude rejection under 35 U.S.C. §102 and/or §103.

The latter paragraph states the rejection of the claims as contained in the current Office action. However, there are inconsistencies between the rejection of the claims as stated in the current Office action and the previous rejection of the claims as stated in the

final Office action of May 20, 2004 (Paper No. 8), and in the Office action of 3 November 2004 (Paper No. 20041021).

Specifically, whereas independent claim 1 and associated dependent claims 4 thru 10, as well as independent claim 11 and associated dependent claims 12 and 15 thru 21, were previously rejected under 35 U.S.C. §103 for alleged unpatentability over Kuo *et al.* '040, those claims are now rejected under 35 U.S.C. §102 for alleged anticipation by Kuo *et al.* '040.

Furthermore, whereas independent claim 22, which was amended in the Amendment After Final filed on 14 July 2004 (Paper No. 9) to include the recitation of dependent claim 25, is now rejected under 35 U.S.C. §102 for alleged anticipation by Kuo *et al.* '040, in the previous final Office action of 20 May 2004 (Paper No. 8), independent claim 22 was rejected under 35 U.S.C. §103 for alleged unpatentability over Kuo *et al.* '040, while dependent claim 25 was rejected under 35 U.S.C. §103 for alleged unpatentability over Kuo *et al.* '040 in view of Kim '130.

In addition, dependent claims 28, 29 and 31 (which are dependent from dependent claim 27) are currently rejected under 35 U.S.C. §102 for alleged anticipation by Kuo *et al.* '040, whereas in the final Office action of 20 May 2004 (Paper No. 8), dependent claims 28, 29 and 31 were rejected under 35 U.S.C. §103 for alleged unpatentability over Kuo *et al.* '040.

Furthermore, dependent claim 30 (which is dependent from claim 29) is currently rejected under 35 U.S.C. §103 for alleged unpatentability over Kuo *et al.* '040, whereas in the final Office action of 20 May 2004 (Paper No. 8), dependent claim 30 was rejected under 35 U.S.C. §103 for alleged unpatentability over Kuo *et al.* '040 in view of Suen *et al.* '750.

Finally, independent claim 32 and associated dependent claim 33 are currently rejected under 35 U.S.C. §102 for alleged anticipation by Kuo *et al.* '040, whereas in the final Office action of 20 May 2004 (Paper No. 8), those claims were rejected under 35 U.S.C. §103 for alleged unpatentability over Kuo *et al.* '040.

In formulating the previous rejections of the claims, which (as stated above) are inconsistent with the current rejection of the claims, the Examiner made various admissions of fact which are inconsistent with the rejections of the claims as presently set forth in the current Office action.

For example, in rejecting independent claims 1 and 11 under 35 U.S.C. §103 for alleged unpatentability over Kuo *et al.* '040 in the previous final Office action of 20 May 2004 (Paper No. 8), the Examiner admitted (in paragraph 3 on page 4 of the final Office action of 20 May 2004, Paper No. 8) that Kuo *et al.* '040 does not disclose a controller which adds a highlight signal to video signals to thereby increase the level of the composed video signals of the highlight portion, and does not disclose a controller which subtracts the highlight signal from the video signals to thereby decrease the level of the composed video

signals of the highlight portion (*see* page 4, lines 10-14 of the final Office action of 20 May 2004 (Paper No. 8). Thus, based on this previous admission by the Examiner, the current rejection of independent claims 1 and 11 under 35 U.S.C. §102 for alleged anticipation is clearly inappropriate.

Further considering the previous rejection of claims 1 and 11 under 35 U.S.C. §103, in the final Office action of 20 May 2004 (Paper No. 8), the Examiner took “Official Notice” that “it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the old and well known superimposing and desuperimposing the highlight signal on the video signal ... since it merely amounts of [*sic*] selecting an alternative equivalent device for adding highlight signal and video signal” (quoting from the sentence bridging pages 4 and 5 of the final Office action of 20 May 2004, Paper No. 8).

In support of the taking of “Official Notice”, the Examiner cited (in paragraph 1 of the final Office action of 20 May 2004, Paper No. 8) Lake Jr., U.S. Patent No. 4,809,070. The Examiner cited this patent “to suggest the capabilities of adding and subtracting the luminance along edges of the luminance field (highlights and shadows)” (quoting from page 3, lines 3-4 of the final Office action of 20 May 2004, Paper No. 8). In the Amendment After Final filed on 14 July 2004 (Paper No. 9) and in the Amendment filed on 19 May 2005 (Paper No. 15), Applicants demonstrated that Lake, Jr. ‘070 was unrelated and not applicable to the pertinent recitations contained in independent claims 1 and 11 of the present application. As a result, Lake, Jr. ‘070 is not cited in the current Office action.

As a result of the above, it is submitted that the current rejection under 35 U.S.C. §102 is clearly inappropriate since, by the Examiner's own admission in the final Office action of 20 May 2004 (Paper No. 8), Kuo *et al.* '040 does not disclose each and every element of claims 1 and 11. However, even if the previous rejection under 35 U.S.C. §103 is applied against independent claims 1 and 11, based on the combination of Kuo *et al.* '040 and the Official Notice previously asserted by the Examiner, a substantial question exists as to the propriety of the taking of "Official Notice" on the part of the Examiner, and this raises a question as to the validity of a rejection under 35 U.S.C. §103 of claims 1 and 11.

In addition, there is nothing within the "four corners" of the disclosure of Kuo *et al.* '040 which would suggest to or instruct a person of ordinary skill in the art as to the necessity or desirability of modifying the disclosure of Kuo *et al.* '040 in the manner suggested by the Examiner. That is, Kuo *et al.* '040 does not contain any suggestion or instruction which would lead a person of ordinary skill in the art to modify the disclosure of Kuo *et al.* '040 so as to provide the controller with the capability of adding or subtracting a highlight signal to or from video signals in order to increase or decrease the level of the composite video signals of the highlight portion.

On page 3 of the current Office action, the Examiner states that the claimed addition of the highlight signals to the video signals to thereby increase the level of the composed video signals and the claimed subtraction of the highlight signals from the video signals to thereby decrease the level of the composed video signals "is met by the presenter uses [*sic*]

the remote controller to change the scope, position, color, brightness, and even the number of the selected area(s), the micro-processor 263 sends a parameter setting signal 350 to the OSP signal generator 330, thus the OSP signal generator 330 generates the control signal 310” (quoting from page 3, lines 11-15 of the current Office action). The Examiner also states that “it is noted that changing the color, brightness, and even the number of the selected area(s) inherent [*sic*] increase (adding) or decrease (subtracting) the level of the composed video signals of the highlight portion” (quoting from page 3, lines 15-18 of the current Office action). It is respectfully submitted that, due to the fact that the Examiner does not provide support, in a form of citation to Kuo *et al.* ‘040 or any other reference; for the statement of “inherency” in the previously quoted passage from the current Office action, there is not proper support for the rejection under 35 U.S.C. §102, or even for a rejection under 35 U.S.C. §103, based on the disclosure of Kuo *et al.* ‘040. In that regard, it should be recognized that a rejection under 35 U.S.C. §102 implies that each and every element and function, or method step, of a claim rejected under 35 U.S.C. §102 for direct anticipation must be disclosed explicitly in the cited reference. Moreover, even in the case of a rejection under 35 U.S.C. §103, there must be sufficient support in the reference or in a combination of references for any statement of “inherency” set forth within the context of the rejection. Thus, for the latter reasons, the rejection under 35 U.S.C. §102 based on Kuo *et al.* ‘040 is clearly inappropriate, and moreover any rejection under 35 U.S.C. §103 based on the same reference must also be subject to serious question.

Further considering independent claim 1, it should be noted that the claim also recites

that the displaying part comprises a control key part for controlling a size and a position of the highlight portion, and that the controller comprises an adjuster part for adjusting the picture in response to external signals adjusted by the control key part. Corresponding recitations are set forth as additional method steps in new dependent method claim 37. The latter recitation further distinguishes the invention of independent claim 1 and dependent claim 37 from the prior art cited by the Examiner since neither Kuo *et al.* '040 nor any of the other references cited in the Office action discloses or suggests the latter feature as now recited in claims 1 and 37. In fact, it is noted that the latter recitation is not at all addressed in the current Office action. Thus, for these reasons in addition to the reasons already stated above, the invention of independent claim 1 and dependent claim 37 is distinguishable from the prior art cited by the Examiner.

Based on the above, it is respectfully submitted that independent claims 1 and 11, and their associated dependent claims, recite the invention in a manner distinguishable from the prior art so as to preclude rejection under 35 U.S.C. §103.

Turning to consideration of independent claim 22, in the final Office action of 20 May 2004 (Paper No. 8), dependent claim 25 was rejected under 35 U.S.C. §103 based on the combination of Kuo *et al.* '040 with Kim '130. Moreover, in the Amendment After Final filed on 14 July 2004, independent claim 22 was amended to include the recitation of dependent claim 25, which was canceled.

In formulating the rejection of claim 25 under 35 U.S.C. §103, the Examiner admitted that Kuo *et al.* '040 did not disclose an image sharpness part for adjusting a signal size representing a borderline of a highlight portion according to a selection by selection means, and for supplying the adjusted signal size to the signal composing part, as previously recited in dependent claim 25. Thus, based on the previous admission by the Examiner, the current rejection of claim 22 (which includes the recitation of previous dependent claim 25) under 35 U.S.C. §102 for alleged anticipation by Kuo *et al.* '040 is clearly not proper. Moreover, the same is true of the rejection of dependent claims 27 thru 29, 31 and 34, which are currently rejected under 35 U.S.C. §102 for alleged anticipation by Kuo *et al.* '040, but which were previously rejected (in the final Office action of 20 May 2004, Paper No. 8) under 35 U.S.C. §103 for alleged unpatentability over Kuo *et al.* '040. For a latter reason, the current rejection of dependent claims 27 thru 29, 31 and 34 under 35 U.S.C. §102 for alleged anticipation by Kuo *et al.* '040 is also not proper.

Further considering the rejection of claim 22, it is noted that, on page 5 of the current Office action, the Examiner states that the recitation of “an image sharpness part connected between said selection means and said signal composing part for adjusting a signal size representing a borderline of the highlight portion according to a selection by said selection means, and for supplying the adjusted signal size to said signal composing part is met by the digital image processor 300, when the presenter uses the remote controller to change the scope, position, color, brightness, and even the number of the selected area(s) (Fig. 2, col. 6, lines 6-24)” (quoting from page 5, lines 5-11 of the current Office action). However, the

portion of Kuo *et al.* '040 cited by the Examiner fails to disclose an image sharpness part connected between selection means and a signal composing part for performing the function recited in the claim. Therefore, a rejection under 35 U.S.C. §102 for direct anticipation is clearly inappropriate. Furthermore, since there is not even a suggestion of the provision of such an image sharpness part in Kuo *et al.* '040, a rejection under 35 U.S.C. §103 is also inappropriate.

Furthermore, as stated above, independent claim 22 was previously amended to include the recitation of dependent claim 25, which was canceled. In rejecting claim 25 (in paragraph 5 of the final Office action of 20 May 2004, Paper No. 8), the Examiner cited the combination of Kuo *et al.* '040 and Kim '130, and admitted that Kuo *et al.* '040 did not disclose the provision of control means further comprising an image sharpness part for adjusting a signal size representing a borderline of the highlight portion according to a selection by the selection means, and for supplying the adjusted signal size to the signal composing part (*see* the second sub-paragraph of paragraph 5 on page 10 of the final Office action of 20 May 2004, Paper No. 8). However, the Examiner alleged that Kim '130 "teaches that the sub-picture display apparatus according to the present invention provides an effect capable of distinctively displaying the sub-picture more definitely and clearly, by thickening the boundary portion of the sub-picture and varying the brightness of the sub-picture to become brighter, in the case that the main picture is complicated spatially or an amount of temporal movement of the main picture is large" (quoting from page 10, lines 11-16 of the final Office action of 20 May 2004, Paper No. 8). In that regard, the Examiner cited Figure

4 and column 3, line 5 - column 4, line 8 of Kim '130.

However, Figure 4 and the cited portion of Kim '130 merely relate to the functioning of a controller 14 to control a signal processor 13 so that a width of a boundary portion between a main picture and a sub-picture has a predetermined first width which can be discerned between the main picture and the sub-picture (*see* column 3, lines 25-30 of Kim '130). The disclosure of the cited patent also describes how the controller 14 controls the signal process 13 so that the width of the boundary portion between the main picture and the sub-picture becomes a predetermined second width (*see* column 3, lines 36-40 of the patent).

Nevertheless, there is no disclosure or suggestion in Kim '130 of the provision of an image sharpness part for adjusting a signal size presenting a borderline of the highlight portion **according to a selection by selection means**, as recited in amended independent claim 22. Furthermore, there is no instruction as to how one of ordinary skill in the art would modify the disclosure of Kuo *et al.* '040 (specifically, Figure 2 thereof) so as to incorporate an image sharpness part into the controller 231 thereof, or into any other portion of the disclosed arrangement of Kuo *et al.* '040, so as to achieve the results achieved by the display apparatus of claim 22 of the present application. Finally, there is no portion of the primary reference (Kuo *et al.* '040), and the Examiner has not cited any portion thereof, which would motivate or suggest to a person of ordinary skill in the art that the disclosure of Kim '130 should be sought for the purpose of modifying Kuo *et al.* '040 in accordance with the disclosure of Kim '130 in an effort to arrive at the present invention.

It is noted that, in response to the latter argument, the disclosure of Kim '130 is no longer being applied against claim 22, and that claim 22 is now being rejected under 35 U.S.C. §102 based on the disclosure of Kuo *et al.* '040 alone. Thus, the Examiner has apparently accepted the argument set forth above.

Finally, it should be noted that, in the Amendment of 19 May 2005 (Paper No. 15), independent claim 22 was further amended to recite that the “signal composing part [is] connected to said highlight signal generating part and to said signal generating means”, and that the “image sharpness part [is] connected between said selection means and said signal composing part” (quoting from the last two paragraphs of independent claim 22). These interconnections, as now recited in independent claim 22, are not disclosed or suggested in the prior art cited by the Examiner, thus providing a further basis for distinguishing the invention from the cited prior art.

For the above reasons, it is submitted that the invention recited in independent claim 22 is distinguishable from the prior art so as to preclude rejection under 35 U.S.C. §102 based on Kuo *et al.* '040, or under 35 U.S.C. §103 for alleged unpatentability over Kuo *et al.* '040, either alone or in combination with any other reference.

With respect to the rejection of independent claim 32 under 35 U.S.C. §102 based on Kuo *et al.* '040, in the previous final Office action of 20 May 2004 (Paper No. 8), claim 32 was rejected under 35 U.S.C. §103 based on Kuo *et al.* '040, whereas in the current Office

action, the Examiner rejects claim 32 under 35 U.S.C. §102 for alleged anticipation by Kuo *et al.* '040. In both previous final Office action and the current Office action, the Examiner alleges that Kuo *et al.* '040 disclosed control means which “further comprises a clock generating part for generating a clock signal to set up a size and a position of the highlight portion” (*see* page 6, lines 14-15 of the current Office action). In that regard, the Examiner alleges that the latter feature is “met by the pixel clock which is timing of displaying the further data (Fig. 3, col. 6, line 25 to col. 7, line 67)” (quoting from page 6, lines 15-17 of the current Office action). The Examiner is apparently referring to the OSP signal generator 330 shown in Figure 3 of Kuo *et al.* '040 as receiving a pixel clock input from the displaying signal generator 256 of Figure 2 thereof. However, Kuo *et al.* '040 does not make it clear as to whether or how the pixel clock input provided to the OSP signal generator 330 results in the setting up of a size and a position of a highlight portion, as alleged by the Examiner. Therefore, it cannot be said that Kuo *et al.* '040 discloses or even suggests the clock generating part recited in independent claim 32. Thus, for these reasons, a rejection of independent claim 32 under 35 U.S.C. §102, or even under §103, is clearly not appropriate.

Dependent claim 33 provides a further basis for distinguishing the invention from the cited prior art in that there is no disclosure or suggestion in Kuo *et al.* '040, or any other reference, of the control means further comprising an adjuster part connected to the clock generating part for receiving a clock signal, and for adjusting a size of the clock signal according to a control signal from selection means. The Examiner alleges (in the last paragraph on page 6 of the current Office action) that these elements and functions are met

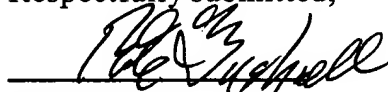
by vertical pixel shift register 404 and horizontal shift register 402, citing column 6, line 25-column 7, line 67 of Kuo *et al.* '040. However, again, it is not clear from the cited patent as to how the shift registers 402 and 404 perform a function of adjusting a size of a clock signal input according to a control signal from selection means, as recited in dependent claim 33.

For the latter reasons, it is submitted that independent claim 32 and associated dependent claim 33 recite the invention in a manner distinguishable from the prior art so as to preclude rejection under 35 U.S.C. §103.

In view of the above, it is submitted that the claims of this application are in condition for allowance, and early issuance thereof is solicited. Should any questions remain unresolved, the Examiner is requested to telephone Applicant's attorney.

A fee of \$50.00 is incurred by the addition of one (1) total claim in excess of total 31. Applicants' check drawn to the order of Commissioner accompanies this Amendment. Should the check become lost, be deficient in payment, or should other fees be incurred, the Commissioner is authorized to charge Deposit Account No. 02-4943 of Applicants' undersigned attorney in the amount of such fees.

Respectfully submitted,



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